

REMARKS/ARGUMENTS

Upon entry of the present amendment, claims 1-10 are pending in the application and presented for examination. Claim 11 is canceled without prejudice or disclaimer. Claims 1-10 are original and unchanged from filing. No new matter is present in this or any other portion of the present amendment. Reconsideration is requested in view of the following remarks.

I. REJECTION UNDER 35 U.S.C. §112, FIRST AND SECOND PARAGRAPHS

Claim 11 stands rejected under 35 U.S.C. §112, first and second paragraphs as allegedly being indefinite for failing to set forth any steps involved in the claimed process. Applicants have canceled claim 11 without prejudice or disclaimer. In view of the cancellation of the claim, Applicants believe that the rejections of the claim under 35 U.S.C. §112, first and second paragraphs are now moot and respectfully request that this rejection be withdrawn.

II. REJECTION UNDER 35 U.S.C. §103(a)

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Nos. 6,825,228 and 6,777,425; and U.S. Pub. Nos. 2003/0236198 and 2003/0199516. Applicants respectfully traverse the rejection. As an initial matter, Applicants note that claim 11 is now canceled and thus the rejection of claim 11 is rendered moot.

It is Applicants' understanding that under the statutory provisions of 35 U.S.C. §103(c) (which is also described in MPEP 706.02(l)(1)), the cited references are disqualified under 35 U.S.C. §103(c) from being a reference that can be relied upon in a 35 U.S.C. 103(a) rejection as each of the cited references are of the 102(e) type, and at the time the claimed invention was made, *all* of the cited references were commonly owned or subject to an obligation of assignment to the same organization. 35 U.S.C. §103(c) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability* under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added)

All of the cited references and the instant application were commonly owned or under an obligation of assignment to a common entity at the time the invention was made.

The instant application (*i.e.*, Application No. 10/732,900) and the cited references (*i.e.*, U.S. 6,825,228, U.S. 6,777,425, U.S. Pub. No. 2003/0236198, U.S. Pub. No. 2003/0199516) were, at the time of the invention, commonly owned by ***GeneSoft Pharmaceuticals, Inc.***, previously GeneSoft, Inc.¹ or under an obligation of assignment to a common entity. At a later date, the entire assets of GeneSoft Pharmaceuticals, Inc. were transferred to Guardian Holdings, LLC., which is wholly owned by Genome Therapeutics Inc., now Oscient Pharmaceuticals Corporation. The instant application is presently assigned to Oscient Pharmaceuticals Corporation.

Applicants provide the following as evidence to the ***common ownership*** of the cited references and the instant application, at the time the invention was made, by ***GeneSoft Pharmaceuticals, Inc.***.

A. **Evidence that each of cited references were owned by GeneSoft Pharmaceuticals, Inc.**

1. A copy of the Sixth Amended and Restated Certificate of Incorporation of GeneSoft Inc., dated September 20, 2002, evidencing that the corporation "GeneSoft, Inc." simply changed its name to "GeneSoft Pharmaceuticals, Inc." as of September 20, 2002. (See, Exhibit 1, in particular the last page of the exhibit)
2. A Notice of Recordation of Assignment Document, dated February 12, 2003, received by the undersigned from the USPTO acknowledging that the request for change of the assignee name from GeneSoft, Inc. to GeneSoft Pharmaceuticals, Inc. in association with, *inter alia*, the patent references cited herein were recorded (See, Exhibit 2):

U.S. Pat. App. No. 10/165,856 (now U.S. 6,825,228)
U.S. Pat. App. No. 10/165,857 (now U.S. 6,777,425)
U.S. Pat. App. No. 10/165,764 (U.S. Pub. No. 2003/0236198)

¹ The cited references were originally assigned to the a company called GeneSoft¹ Inc. that later simply changed its name to GeneSoft Pharmaceuticals Inc.

U.S. Pat. App. No. 10/244,142 (U.S. Pub. No. 2003/0199516)

- B. Evidence that the claimed invention in the instant application was owned by GeneSoft Pharmaceuticals, Inc. and subject to assignment to GeneSoft Pharmaceuticals, Inc. at the time the invention was made.
3. A copy of the title page of the instant application, as filed on December 9, 2003, evidencing that GeneSoft Pharmaceuticals, Inc. was to be the assignee for the application. At the time of the invention, the named inventors on the application were employed by Genesoft Pharmaceuticals, Inc. It is the understanding of the undersigned that the inventors, by the terms of their employment agreement, would have been under an obligation to assign the rights of their invention to GeneSoft Pharmaceuticals, Inc. (See, Exhibit 3 for a copy of the title page of the application as filed on December 9, 2003)
 4. Applicants note that the Notice of Recordation and Assignment Document discussed above (See, Exhibit 2) also sets forth that Provisional App. No. 60/432,465, which is the priority document to the instant application, as one the documents in which the assignment was changed to GeneSoft Pharmaceuticals, Inc.
- C. Supplementary evidence showing the transfer of assets from GeneSoft Pharmaceuticals, Inc. to Genome Therapeutics Inc., now Oscient Pharmaceuticals Corporation, the assignee of the instant application. Specifically, the following documents show that on February 6, 2004, which was after the filing date of the instant application (December 9, 2003) but prior to the date of filing of the Assignment documents (September 7, 2004) for the instant application, GeneSoft Pharmaceuticals, Inc. was merged with Guardian Holdings LLC which is wholly owned by Genome Therapeutics, Inc., now Oscient Pharmaceuticals, Corp. This merger resulted in the present assignment of the application to Oscient Pharmaceuticals, Corporation.
5. A copy of the Limited Liability Company Agreement of Guardian Holdings, LLC, dated November, 12, 2003, evidencing that Genome Therapeutics (now Oscient Pharmaceuticals Corporation) is the sole member and owner of Guardian Holdings, LLC. (See, Exhibit 4)

6. A copy of the Agreement of Merger, dated February 6, 2004, evidencing the agreement for the merger of GeneSoft Pharmaceuticals Inc. in to Guardian Holding (owned by Genome Therapeutics, now Oscient Pharmaceuticals Corporation). (See, Exhibit 5)
7. A copy of the Certificate of Merger, dated February 6, 2004, evidencing that the merger became effective and the name of Guardian Holding, LLC was changed to GeneSoft Pharmaceuticals, Inc. (See, Exhibit 6)

In view of the above, Applicants believe that the references cited herein (*i.e.*, U.S. 6,825,228, U.S. 6,777,425, U.S. Pub. No. 2003/0236198, U.S. Pub. No. 2003/0199516) in the §103(a) rejection are disqualified as prior art under 35 U.S.C. §103(c) as the cited references are §102(e) type references, and were at the time the claimed invention was made, commonly owned or subject to assignment to GeneSoft Pharmaceuticals, Inc. As the cited references cited are disqualified under the provisions of §103(c), Applicants submit that the current rejection under §103(a) is untenable, and as such, Applicants respectfully request that the rejection of claims 1-10 be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. §102(e)

Claims 1-11 also stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent Nos. 6,825,228 and 6,777,425; and U.S. Pub. Nos. 2003/0236198 and 2003/0199516. Applicants note that the same references were cited in the above 103(a) rejection. Applicants also note that as claim 11 is presently canceled, the rejection of this claim is rendered moot. Insofar as the rejection is applicable to the remaining claims (*i.e.*, claims 1-10), Applicants respectfully traverse the rejection.

Applicants respectfully point out that while the Examiner states that claims 1-11 are anticipated by each of the references cited in the rejection, the Examiner has not provided any support or reasoning as to why the claims are anticipated. If it is actually the intent of the Examiner to present this rejection as part of the 103(a) rejection (discussed above), for example, as a 102(e)/103(a) rejection, Applicants believe that pursuant 35 U.S.C. §103(c), the showing that the cited references and the instant application were both subject to assignment to the same

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organization (*i.e.*, GeneSoft Pharmaceuticals Inc.) at the time the invention was made, is sufficient to overcome the rejection.

If it is, however, the Examiner's intent to set forth the 102(e) rejection as an independent rejection, separate from the above 103(a) rejection Applicants submit that a proper response to this rejection cannot be made unless the Examiner articulates a clear basis for the rejection of the claims over the each of the cited references. Applicants would sincerely appreciate further clarity from the Examiner with regard to this rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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